

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Thiele, Jr.

Serial No.: 10/827,564

Group Art Unit: 3654

Filed: April 19, 2004

Examiner: E. Okezie

For: SHOVELS AND OTHER IMPLEMENTS WITH SCALLOPED LEADING EDGES

APPELLANT'S BRIEF UNDER 37 CFR §1.192

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. Real Party in Interest

The real party and interest in this case is Richard Thiele, Jr., Applicant and Appellant.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with 12 claims. Claims 1-12 are pending, rejected and under appeal. Claim 1 is the sole independent claim.

**IV. Status of Amendments Filed Subsequent
Final Rejection**

No after-final amendments have been filed.

V. Summary of Claimed Subject Matter

Independent claim 1 is directed to an improved blade for a shovel having an elongated handle

(102). The blade comprising a scoop portion (104, 204) having a width (W), a length (L), and a leading edge furthest away from the handle. A plurality of concave scallops (110, 602, Figures 1-6) are present on the leading edge. Each scallop defines a segment of a single circle, and the segments intersect at distinct forward points in a straight line generally perpendicular to the handle. (Specification, page 2 line 19 to page 4, line 9). For reference, Appellant's Figure 1 is reproduced below:

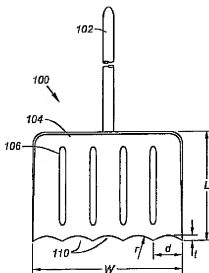


Fig - 1

VI. Grounds of Objection/Rejection To Be Reviewed On Appeal

A. The rejection of claims 1-12¹ under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,014,434 to Skerker et al. in view of U.S. Patent No. 3,877,143 to Montesi.

B. The rejection of claim 12 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,014,434 to Skerker et al. in view of U.S. Patent No. 6,497,439 to Guo.

VII. Argument

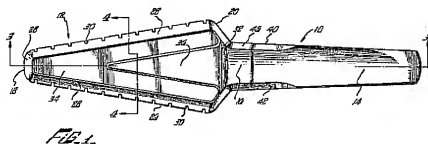
A. The Rejection of claim 1, wherein claims 2-11 stand/fall therewith.

Appellant's claim 1 resides in an improved blade for a shovel. The claim includes the

¹ Although the Examiner lists claim 12 in the rejection under 35 U.S.C. §103(a) over U.S. Patent No. 5,014,434 to Skerker et al. in view of U.S. Patent No. 3,877,143 to Montesi, claim 12 is not argued in the body of the rejection. Since a second rejection of claim 12 is made under §103(a) over U.S. Patent No. 5,014,434 to Skerker et al. in view of U.S. Patent No. 6,497,439 to Guo, Appellant believes the rejection of claims 1-12 should read "1-11."

limitations of "a scoop portion having ... a leading edge furthest away from the handle; a plurality of concave scallops on the leading edge, each scallop defining a segment of a single circle; and wherein the segments intersect at distinct forward points in a straight line generally perpendicular to the handle.

Claim 1 stands under 35 U.S.C. §103(a) over U.S. Patent No. 5,014,434 to Skerker et al. in view of U.S. Patent No. 3,877,143 to Montesi. Skerker resides in "a kitchen tool integrally formed in one piece made of a polyetherimide, having a capacity for withstanding high temperatures and facilitating microwave use." ('434 patent, Abstract). The Examiner concedes that "Skerker does not disclose these scallops furtherest [sic] away from the handle and generally perpendicular to the handle." To address this deficiency, the Examiner proposes the combination of Skerker with Montesi. Montesi resides in "a pastry tool or implement that is suitable for use in cutting and serving various pastry products. More particularly, [Montesi] relates to a blade construction ... that will enable the user to readily and easily separate the pastry product from its container as well as easily release that product as it is placed upon a suitable serving dish. Figure 1 of Montesi is reproduced below:



The Examiner's argument is that it would have been obvious to modify the tool of Skerker to include "a serrated type knife edge all around its peripheral edge" as taught by Montesi in order to facilitate the use of the edge in cutting at different orientations and "...to enhance the complete end effective removal" of products being sliced or lifted."² This argument is flawed on several grounds.

**Even if Skerker Were Combined with Montesi,
Appellant's Invention Would Not Result.**

Although Montesi does mention "a serrated type knife edge all around its peripheral edge," it is

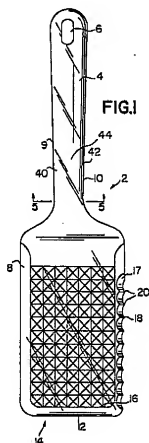
clear from the disclosure and drawings of the '143 patent that the *forward edge 18 does not include serrations*. First according to Montesi, "[t]he peripheral edge 26 is beveled all around in knife edge like fashion 28 [sic]. Furthermore, such edge is notched as at 30 *to provide for improved cutting characteristics*. ('143 patent, col. 2, lines 22-24, emphasis added). Thus, the serrations are intended to cut. Montesi additionally states that "[i]t is additionally apparent from FIG. 1 [see above] that the apex end 18 is of a blunted nature thus avoiding a dangerous point that might inadvertently cause serious injury to the user." ('143 patent, col. 2, lines 14-17). Thus, the apex end 18 is intended not to cut. To add serrations to the forward edge 18 "might inadvertently cause serious injury to the user," a possibility that Montesi clearly seeks to avoid. That serrations would be superfluous to the tip of the Montesi implement is also evident the fact that the Montesi article is intended for side-to-side movement (see Figure 6 of the '143 patent).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In this instance, the teaching or suggestion to make the claimed combination comes only from Appellant's disclosure and even if the combination were made, the combined prior-art references do not teach or suggest all the claim limitations.

Skerker Teaches Away From Distal Serrations

Figure 1 of the '434 patent is reproduced at the top of the following page.

² The actual quote reads "to enhance the complete and effective removal of *pie products*."



“The turner 2 of FIG. 1 is a single piece kitchen tool formed by conventional injection molding. ... The work end 8 is provided with a tapered edge 12 at the front end 14 adapted to facilitate gaining access to the bottom of the food being worked by the work end 8. For example, the tapered edge 12 facilitates reaching under the egg or hamburger to be turned. A third side 18 of the work end 8 is a blade type edge provided with serrations [sic] 20. Again, the serrations 20 are tapered. The serrations 20 can be used to cut food into separate pieces without using a knife. In addition, the serrations 20 can be used for decorating purposes when the third side 18 having the serrations 20 is passed across icing on the top of a cake.”

Certain points are clear from this disclosure. First, since the tapered edge 12 (furthest from and generally perpendicular to the handle 4) is intended for “reaching under an egg or hamburger,” it would be less effective with serrations, which is why the serrations are relegated to the side of the implement. Second, since the side 18 with the serrations 20 is intended for cutting food without the need for a knife or for being “passed across icing on the top of a cake,” relocation of the serrations to the forward edge 12 would confound these intended purposes. It would be awkward, using handle 4, to cut with the

forward edge 12 or pass forward edge 12 across icing on the top of a cake, serrations or no serrations.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). If a proposed modification would render the prior-art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Since the serrations of Skerker are intended only for cutting and icing texturing, location of the serrations only makes sense on the side edge. Placement of the serrations on the distal end of the Skerker implement would not advance Skerker's intended purpose and they would be less effective for reaching under food.

B. The rejection of claim 12 under 35 U.S.C. §103(a) over Skerker et al. in view of Guo.

Claim 12 adds to claim 1 the limitation that "the leading edge and scoop portion are constructed from dissimilar materials." It is not even necessary to interpret the teachings of Guo, since the point of novelty of Skerker is *unitary construction*. "The handle 4, work end 8 and connection section 10 are one continuous integral piece formed of the same material." ('434 patent, col. 3, lines 12-14) If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In this case, the goal of "the same material" could be interpreted as a "principle of operation."

Conclusion

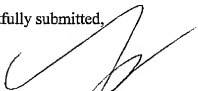
In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board's concurrence at this time.

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Respectfully submitted,



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APPENDIX ACLAIMS ON APPEAL

1. An improved blade for a shovel having an elongated handle, the blade comprising:
a scoop portion having a width, a length, and a leading edge furthest away from the handle;
a plurality of concave scallops on the leading edge, each scallop defining a segment of a single circle; and
wherein the segments intersect at distinct forward points in a straight line generally perpendicular to the handle.
2. The improved shovel of claim 1, wherein:
the width of the scoop portion ranges between 6 and 24 inches; and
the number of scallops ranges between 3 and 12.
3. The improved shovel of claim 1, wherein:
the points are spaced apart by a distance 'd'; and
the radius of each scallop, 'r,' is greater than $d/2$.
4. The improved shovel of claim 1, wherein:
the points are spaced apart by a distance 'd'; and
the radius of each scallop, 'r,' is substantially equal to 'd'.
5. The improved shovel of claim 1, wherein:
the spaced are apart by a distance 'd'; and
the radius of each scallop, 'r,' is greater than 'd'.
6. The improved shovel of claim 1, wherein the scallops are substantially identical.
7. The improved shovel of claim 1, wherein the scoop portion is configured for snow

shoveling.

8. The improved shovel of claim 1, wherein the scoop portion includes stiffening ribs.
9. The improved shovel of claim 1, wherein the scoop portion is configured for gardening
10. The improved shovel of claim 1, wherein the scoop portion is configured for ice scraping.
11. The improved shovel of claim 1, wherein the leading edge is attached to the scoop portion.
12. The improved shovel of claim 1, wherein the leading edge and scoop portion are constructed from dissimilar materials.

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APPENDIX B

EVIDENCE

None.

APPENDIX C
RELATED PROCEEDINGS

None.